



UNITED STATES DEPARTMENT OF COMMERCE
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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
09/138,218	08/21/98	TARKIAINEN	M 466-008195-U

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LM01/0316

EXAMINER

GESESSE, T

ART UNIT

PAPER NUMBER

2746

DATE MAILED:

03/16/00

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.

09/138,218

Applicant(s)

Tarkiainen et al

Examiner

Gesesse, Tilahun

Group Art Unit

2746



☒ Responsive to communication(s) filed on Aug 21, 1998

☐ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire three month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

☒ Claim(s) 1-8 is/are pending in the application.

Of the above, claim(s) _____ is/are withdrawn from consideration.

☐ Claim(s) _____ is/are allowed.

☒ Claim(s) 1-8 is/are rejected.

☐ Claim(s) _____ is/are objected to.

☐ Claims _____ are subject to restriction or election requirement.

Application Papers

☒ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☒ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☒ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been

☒ received.

☐ received in Application No. (Series Code/Serial Number) _____.

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☒ Notice of References Cited, PTO-892

☒ Information Disclosure Statement(s), PTO-1449, Paper No(s). 3 and 4

☐ Interview Summary, PTO-413

☒ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

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DETAILED ACTION

Specification

1. The title of the invention is not descriptive. A new title is required that is clearly indicative of the invention to which the claims are directed.

Claim Rejections - 35 USC § 112

2. Claims 1-8 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The claims are generally narrative and indefinite, failing to conform with current U.S. practice. They appear to be a literal translation into English from a foreign document and are replete with grammatical and idiomatic errors. For instance , the term characterized does not distinctly point out the claim subject matter which applicant regards as the invention.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who

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has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371© of this title before the invention thereof by the applicant for patent.

4. Claims 1-8 are rejected under 35 U.S.C. 102(e) as being anticipated by Pepe et al (5,742,905) .

As per claims 1-2,4 and 6-7 Pepe et al disclose method for the transmission of messages by using a message service to the mobile station of a recipient (a cellular phone 32) , who uses at least a primary mobile station , in which there is at least one secondary mobile station in which at least the possibility to receive messages (portable message equipment (PDA)30,a cellular phone 32 and pager 34, connected to wireless network 39, see col. 5 lines 41-53) , in which the is that the message addressed to the primary mobile station can be directed to any of the secondary mobile sation of the recipient, irrespective of calls (a personal communications internet working network (PCI) 40 is connected between the wireless 39 and wireline network 29 and permits the mobile communication subscriber to send and receive messages between disparate networks and messaging systems and variety of service providers, see col.5 lines 54-59)

Further more, the subscriber may have notification of a voice mail or fax message receipt directed to a wireless PDA in the form of e-mail or fax messages. If the subscriber's wireless PDA is not turned on, or otherwise not operating, the notification may be routed to an alternate wireless or wireline network. Notification to the subscriber that a voice mail message was received may be , for example , rerouted to the subscriber pager and notification that a fax has been received may be rerouted to the wireline e-mail, see col. 6 lines 11-19..

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As per claim 3, Pepe et al fails to disclose explicitly that the messages are generated on the basis of calendar events. However, it is inherent the Pepe's message to be calendar events, such as meeting highlights (topics for to be discussed), schedules and any short text infomations.

As per claims 5 and 8, Pepe et al disclose the data computer(22 see fig.1) and if the message is not acknowledged at a determined time the message is forward to the activated mobile station (if the subscriber's identity is validated , the PCI downloads the subscriber's modifiable profile elements. Attached as appendix C is alist of tags for modifiable profile elements, PDA 30 acknowledges the received data . The PDA starts a timer after sending the download request , see col.22 lines 14-31.

Conclusion

5. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Roach Jr. et al disclose the operation of the paging acknowledgment system 10', a party desiring to contact another party at a remote site forwards a paging message via a communications network 151 for eventual transmission by the paging terminal 150. In response to the paging message , the paging terminal 150 transmits a data message , see col.27 lines 2-24 and fig.7.

Any response to this action should be mailed to:

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Washington, D.C. 20231

or faxed to:

(703) 308-9051, (for formal communications intended for entry)

Or:

*(703) 305-9508 (for informal or draft communications, please
label "PROPOSED" or "DRAFT")*

*Hand-delivered responses should be brought to Crystal Park II, 2121 Crystal Drive,
Arlington, VA., Sixth Floor (Receptionist).*

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Tilahun Gesesse whose telephone number is (703) 308-5873.. The examiner can normally be reached on Monday-Thursday from 6:30 am to 5:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Fan Tsang, can be reached on (703) 305-4895 The fax phone number for this Group is (703) 308-6306 or (703) 308-6296.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 305-3900.

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Mar.7, 2000

Tilahun Gesesse

E. Urban
EDWARD F. URBAN
PRIMARY EXAMINER

